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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,894	03/15/2001	Kazuhiro Yamaguchi	450100-03068	5274

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EXAMINER	
DANG, KHANH NMN	

ART UNIT	PAPER NUMBER
2111	12

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/808,894	YAMAGUCHI ET AL.	
	Examiner	Art Unit	
	Khanh Dang	2111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 21-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 21-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to because boxes shown in Figs. 1-4 have not been all labeled. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the newly added term "active antenna" to claim 1. The term antenna described in the specification is inherently an active antenna, since it requires power to operate. However, proper antecedent basis for the term "active antenna" must be provided in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skarda et al.

Skarda et al. discloses a broadcasting receiver having a standby state and a normal state of power supply, comprising: an antenna device (antenna in Skarda et al.) for receiving broadcast signals having a frequency associated therewith (as in any satellite antenna, the antenna of Skarda et al., connected directly to the GPS receiver through hardware connectors, is an external antenna for receiving broadcast signals having a frequency associated therewith); a slot (PCMCIA GPS Card slot for receiving a peripheral device such as a GPS having an antenna, for example) for inserting a storage medium on which subscription information for receiving a broadcast is recorded (any commercial GPS always includes a storage medium on which subscription info for receiving a GPS broadcast is recorded); a sub-unit including a number of circuits for processing the signals and subscription information (it is inherent that the GPS receiver of Skadar et al. must including signal processing circuits for processing the received signals and subscription information); a detecting means (sensing means in Skarda et al.) for detecting presence or absence of said storage medium inserted in said slot; and a control means (power conversion means in Skarda et al.) for controlling power supply to the GPS receiver having an external antenna connected thereto, and to the number of circuits of the sub-unit; wherein when the broadcasting receiver is in the standby state and the power conversion means of Skarda et al. does not detect insertion of the storage medium, the power conversion means stops power supply to the GPS receiver having the external antenna connected, and resumes power supply to the GPS receiver

having the external antenna connected thereto, and to the number of circuits of the sub-unit when the broadcasting receiver is in the normal state and the detecting means (sensing means in Skarda et al.) detects insertion of the storage medium. With regard to claims 25 and 26, it is clear that the user info and subscription are supplied when the GPS is inserted into the slot provided by the PCMCIA, and are processed by a user information processing circuit for processing the subscription information so that the user can view a content or program.

Skadar et al. does not disclose whether the external GPS antenna is a passive antenna or an active antenna comprising a converter circuit. It is well-known that there are only two types of GPS antenna, namely passive antenna and active antenna. The passive antenna does not require power to operate whereas the active antenna requires power of about 5V at the antenna connector of the GPS receiver to power the converter/amplifier circuits, and is usually used as external antenna. For more information on the passive and active antennas, a Google search on the subject may be helpful.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select an active type for the external antenna of Skadar et al. for the purpose of providing better, satisfactory, and more reliable signal reception to the GPS receiver of Skadar et al., since the Examiner takes Official Notice that both passive and active GPS antennas are old and well-known in the art, and particularly active antenna is widely known for its use as an external antenna; and selecting an active antenna for the purpose of providing the GPS receiver of Skadar et al. with better,

satisfactory, and more reliable signal reception only involves routine skill in the art. Note that when an active antenna is selected for Skadar et al., it is clear that the active antenna of Skadar et al., as any conventional GPS active antenna, requires power to operate and the power conversion means of Skadar et al. must supply power the antenna trough the GPS receiver, since the antenna is directly coupled to the antenna terminal of the GPS receiver through hardware connector (see Skadar et al.) to receive power from the Skadar et al.'s GPA receiver. It is also clear that the power controller of Skadar et al. stops power supply to the GPS receiver and in effect, to the antenna and to the number of circuits of the sub-unit, since the active antenna of Skadar et al. is directly connected to the GPS receiver through hardware connectors; and resumes power supply to the GPS receiver and in effect, to the antenna and to the number of circuits of the sub-unit when the broadcasting receiver is in the normal state and the detecting means (sensing means in Skarda et al.) detects insertion of the storage medium. With regard to claims 27 and 28, it is inherent that the selected GPS external active antenna of Skadar et al. comprises a low noise frequency converter and amplifier, since all GPS active antennas, by design, must include a low noise frequency converter and amplifier. Again, for more information on the passive and active antennas, a Google search on the subject may be helpful. If Applicants still choose to properly challenge the fact that there are only two types of GPS antenna, namely passive and active antenna, and that passive and active antenna are old and well-known, supportive document(s) will be provided upon request.

Response to Arguments

Applicants' arguments filed 4/22/2004 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997)*. In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.,* 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The Skadar et al. 103(a) Rejection:

With regard to claims 1, Applicant argues that Skadar does not disclose "active antenna" and "said control means stops power supply to the "active antenna device" when the receiver is in standby state and the detecting means does not detect insertion

of said storage medium. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In any event, it is clear that when an active antenna is provided to Skadar et al., it would, as any conventional GPS active antenna, by design, requires power to operate; and the "control means" or power conversion means of Skadar et al. must supply power the antenna trough the GPS receiver. Without power, the GPS active antenna of Skadar simply will not be able to operate. A conventional active antenna requires power of about 5V at the antenna connector of the GPS receiver to power the converter/amplifier circuits of the antenna. It is also clear that when the broadcasting receiver of Skadar et al. is in a standby state and the power conversion means of Skarda et al. does not detect insertion of the storage medium, the power conversion means stops power supply to the GPS receiver and in effect, to the antenna, since the active antenna of Skadar et al. is directly connected to the GPS receiver through hardware connectors to receive power from the GPS receiver, and to the number of circuits of the sub-unit. Applicant also argues regarding the Official Notice that the "Examiner fail to cite a reference or references." At the outset, MPEP 2144.03 clearly states that "it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence." Further, MPEP 2144.03(c) also clearly states that in order to "adequately traverse such a finding, an applicant must specifically point out the

supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ ... A general allegation that the claims define patentable invention without any reference to the examiner's assertion of official notice would be inadequate." Thus, in light of the MPEP 2144.03, it is clear that a mere allegation or a bald statement such as, the "Examiner fails to cite a reference or references" is not adequate and does not shift the burden to the Examiner to provide evidence in support of the Official Notice. Allowing such a statement to challenge Official Notice would effectively destroy any incentive on the part of the Examiner to use it in the process of establishing a rejection of notoriously well-known facts. In the instant case, as noted above, Applicant has not provided any adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefore, a presentation of a reference/document to substantiate the Official Notice is not deemed necessary. The Examiner's taking of Official Notice has been maintained. In any event, contrary to Applicant's argument, the Examiner clearly stated in the previous Office Action that "[f]or more information on the passive and active antennas, a Google search on the subject may be helpful." Applicant also argues that the Examiner's 103 rejection lacks motivation or "desirability" citing "In re Fritch" for support. Contrary to Applicant's argument, in the previous Office Action, the 103 rejection clearly stated that "selecting an active antenna for the purpose of providing the GPS receiver of Skadar et al. with better, satisfactory, and more reliable signal reception."

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.

Khanh Dang
Primary Examiner